

Notice of Allowability

Application No.

09/281,717

Examiner

Marjorie A. Moran

Applicant(s)

BAXTER ET AL.

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/12/05.
2. ☒ The allowed claim(s) is/are 1-16, 31-43 and 52-62.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☒ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date <u>20050222</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date <u>7/29/04</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input checked="" type="checkbox"/> Other <u>Notes about drawings</u> . |

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 7/29/04 has been entered.

Claims 1-16, 31-43 and 52-62 are pending.

Information Disclosure Statement

The IDS filed 7/29/04 has been considered in full. It is noted that an IDS was filed 1/12/2005, but was missing the list of references. It is noted that a list may have been supplied by applicant but separated from the references by the PTO during processing. In an effort to advance prosecution, the examiner has considered the foreign patent and international documents and nonpatent literature filed with the IDS and has listed the considered documents on a PTO Form 892.

Drawings

The drawings filed on 3/30/1999 are acceptable subject to correction of the objections which follow. A PTO Form 948 was mailed 6/14/00, and a copy was again mailed with the Notice of Allowance on 6/30/04. In the response filed with the RCE of

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7/29/04, applicant requested clarification of the Draftsperson's objections. The draftsperson objected to Figures 1, 8, 9, and 10. Figure 1 is acceptable to the examiner. It is again noted that a proposed correction to Figure 7 was filed 11/18/02 and has been approved; however, a formal copy of an amended drawing has not been received. Figures 8-11 are objected to by the examiner for the following reasons:

Figure 8 does not clearly indicate what each graph is showing; e.g. by a Figure legend under or over each bar graph. The brief description of the drawings in the specification does not clearly indicate what each graph indicates. Pages 31-32 of the specification disclose that Figure 8 shows that GRIP1 binds to receptors in a ligand-dependant manner, and suggests that one graph indicates binding in the presence of ligand and one in the absence of ligand. Applicant is requested to clearly indicate, either in the specification or by use of Figure legends, what each bar graph in Figure 8 is intended to represent. Applicant is reminded that any amendment to the specification or drawings may not introduce new matter, and is strongly encouraged to point, by page and line number, to support in the originally filed disclosure for any information added by amendment to either the specification or drawings. In addition, the shadings in Figure 8 are difficult to distinguish; in particular, NRb 1,2,3 and Nrb 1 look the same (both are solid black). Applicant is encouraged to use cross-hatching or horizontal hatching to clearly distinguish each bar.

Figure 9 shows sequences which are not identified therein nor in the description of the Figures in the specification. Applicant is reminded that sequences must be identified by SEQ ID NO: wherever they appear in the disclosure, including figures.

Figure 10 does identify the particular residue numbers and SEQ ID NO: for the sequences displayed therein and is NOT objected to for this reason. However, the shading for some of the sequences in Figure 10 makes them difficult to see. It is recognized that this may be due to copying/scanning procedures by the PTO; however, applicant is requested to remove the dark shading and/or use some other form of designating/highlighting sequences that does not cause them to be "blacked out" upon copying or scanning.

Figure 11 was printed such that upon processing of the paper case, a hole was punched into one of the graphs. The examiner apologizes for the inconvenience and requests that applicant supply another clean copy of Figure 11.

In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: the prior art of record neither teaches nor fairly suggests a method of identifying a compound which binds to a nuclear receptor coactivator binding site using an atomic structural model of the nuclear receptor coactivator binding site, as recited in the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Claims 1-16, 31-43 and 52-62 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon,Wed: 7-1:30; Tue,Thur: 7:30-6; Fri 7-3:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran
Primary Examiner
Art Unit 1631

Marjorie A. Moran
2/22/05